REMARKS/ARGUMENTS

Applicants received the Office Action dated August 27, 2004, in which the Examiner (1) objected to the drawings; (2) objected to the specification; (3) rejected claims 1, 5, 13, 14, and 17 as anticipated by Yinger (U.S. Patent No. 5,960,204); (4) rejected claims 3, 4, 6, 16, and 18 as obvious over Yinger in view of "Computer User's Dictionary by Microsoft Press" (hereinafter "Microsoft"); (5) rejected claims 7-9 and 11 as obvious over Yinger in view of Heath (U.S. Patent No. 6,006,034); (6) rejected claims 10 and 12 as obvious over Yinger in view of Heath and Microsoft; and (7) rejected claim 15 as obvious over Yinger in view of Mohammed (U.S. Patent No. 6,418,555). In this response Applicants amend the specification, drawings, and claims 1, 7, 8, and 13 and cancel claims 3, 4, 6, 10, 12, 16, and 18. In light of the amendments and arguments contained herein, Applicants respectfully request reconsideration in allowance of all pending claims.

Amendments to Specification and Drawings

The specification and drawings are hereby amended to comply with 37 CFR 1.77(b) and 37 CFR 1.83(a) respectively. Additionally, the summary section of the specification is hereby amended to correspond with the amended description of amended claims 1, 7 and 13.

Response to Rejections of Claims 1, 5, 13, 14 and 17 under 35 USC § 102

Claims 1 and 13 have been amended to overcome the rejections under 35 USC § 102. Amended claim 1 recites a method of distributing software over a communication network. The method includes the steps of making the software available on a file server attached to the network; providing and executing an installation application on a user's computer attached to the network; monitoring file requests made by the installation application; identifying file requests which relate to files which are not present on the user's computer; converting file requests into file download requests; downloading the identified files from the file server; storing the downloaded files in storage media on the user's computer; and directing the file requests for the identified files, and any future file requests for those files, to the downloaded versions of those files.

Amended claim 13 recites a method of automatically upgrading software on a user's computer over a communication network. The method includes the steps of making the upgrade software available on a file server attached to the network; ascertaining that the software on the

user's computer is an older version than the upgrade software; executing the software on the user's computer and monitoring file requests made by the software; identifying the requests which relate to files which have been upgraded in the upgrade software; converting file requests into file download requests; downloading the identified files from the file server; storing the downloaded files in storage media on the user's computer; and directing the file requests for the identified files, and any future file requests for those files, to the downloaded versions of those files.

Specifically, each method in amended claims 1 and 13 recites conversion of file requests into file download requests directed to a file server or redirected to downloaded files located on a user's computer. Basis for the amendment to claims 1 and 13 can be found in page 5 lines 9 to 11 and more specifically, in page 9 lines 12 to 25 of the specification thereof without adding matter.

Although Yinger discloses a method for installing new applications and updating existing applications on a computer node within computer network environment, the installation and updating of applications are not applicable to hard-coded applications, which require a specific location or any specific file from the specific location for the installation and updating. Yinger therefore does not in any way teach or intimate, according to amended claims 1 and 13 of the present application, a method for converting file requests into file download requests such that any file request for installing and updating of applications can be directed to a file server or redirected to downloaded files located on a user's computer, hence enabling hard-coded applications to be installed and updated from alternative locations other than the specific location or any specific file from the specific location.

Additionally, although Yinger discloses a method for determining whether an application exists on a client computer, no monitoring of file requests made by an installation application or software is apparent in Yinger. Yinger therefore does not in any way teach or intimate, according to amended claims 1 and 13 of the present application, a method for monitoring file requests such that only specific files needed by the installation application or software are requested. Applicants respectfully submit that it is therefore apparent that monitoring file requests as recited in amended claims 1 and 13 is distinct from determining whether an application exists on a client computer as disclosed in Yinger.

142744.02/2085.00100

Based on the above amendments and arguments, Applicants respectfully submit that amended claims 1 and 13 are not anticipated by Yinger.

Claim 5 and claims 14, 17 are dependent on claims 1 and 13 respectively and should be read in conjunction therewith. Therefore, when amended claims 1 and 13 are not anticipated by Yinger, claim 5 and claims 14, 17 being further restrictions on amended claims 1 and 13 respectively are consequently not anticipated by Yinger.

Claims 2-4, 6-12, 15-16 and 18

Claim 7 has been amended to overcome the rejections under 35 USC § 103. Claims 1 and 13 have also been amended. Claims 3 to 4, 6, 10, 12, 16 and 18 are canceled.

Applicants respectfully agree with Examiner that Hewitt Smith teaches restricting access to software to a paying customer.

Applicants however respectfully traverse Examiner's statement that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Hewitt Smith's billing method in Yinger's software distribution system" as Hewitt Smith's billing method is directed to an entire software application and not, according to claim 2 of the present application, monitoring the frequency of request for individual files that constitute the software application. A person having ordinary skill in the art would have to first be able to appreciate the inner workings of a method for monitoring file requests such that only specific files needed for installation are requested, as recited in amended claim 1, prior to monitoring the frequency of request for individual files that constitute the software application, as recited in claim 2.

The method according to claim 2 performs substantially different functions vis-à-vis the teachings in Yinger and Hewitt Smith. Accordingly, Applicants respectfully submit that claim 2 is not obvious.

Amended claim 7 recites a method of executing computer application software on a user's computer which is connected to a communication network. The method includes the steps of providing on the user's computer a version of the software which does not include all the files necessary for complete operation of the software; making the missing files available on a file server attached to the network; executing the software on the user's computer; monitoring file requests made by the software; identifying file requests which relate to files which are not present on the user's computer; converting file requests into file download requests;

142744.02/2085.00100

downloading the identified files from the file server and storing them in volatile or non-volatile storage media on the user's computer; and directing the file requests for the identified files to the downloaded versions of those files.

Specifically, the description of the method in amended claim 7 describes conversion of file requests into file download requests directed to a file server or redirected to downloaded files located on a user's computer. A person having ordinary skill in the art after having read Yinger and Heath would be taught to operate on software applications that are not hard-coded. It is therefore not obvious to the person having ordinary skill in the art to allow execution of computer application software through a communication network for hard-coded applications. As such, claim 7 and all claims dependent therefrom are patentable.

Although Heath discloses the use of a "catalog file that can also be specified to include a procedure to delete the components following the execution of the updated application program", no option is available for the deletion of the files, as recited in claim 8 of the present application, as the files are closed by the software, or when execution of the software terminates, or after a pre-determined time or number of days has elapsed; and/or after the software has been executed a pre-determined number of times. Heath therefore does not in any way teach or intimate the provision of the four options, as recited in claim 8 of the present application, for deleting one or more of the downloaded files on a user's computer connected to a communication network.

Furthermore, Yinger and Heath, when read individually or in combination, do not teach in any way or intimate a method, according to claim 9 of the present application, for monitoring the frequency of request for individual files that constitute the software application. The monitoring of the frequency of request for individual files that constitute the software application is not apparent in both Yinger and Heath.

Since the method according to amended claim 7 and claims 8 and 9 perform substantially different functions vis-à-vis the teachings in Yinger and Heath, amended claims 7-9 are clearly not obvious.

Mohammed teaches a method for detecting an operation system and subsequent upgrading of the operation system. A detection module is provided for monitoring the upgrading of the operating system.

142744.02/2085.00100

Mohammed therefore teaches a detector for monitoring the upgrading of the operating system but does not in any way teach or intimate, according to claim 15 of the present application, an upgrade agent that monitors file requests made by an older version software. The monitoring of the file request allows identification and conversion of the file requests such that the file requests can be directed to a file server or redirected to downloaded files located on a user's computer, hence enabling hard-coded applications to be installed and updated from alternative locations.
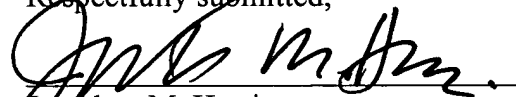
Applicants respectfully submit that it is therefore apparent that monitoring file requests as recited in claim 15 is distinct from monitoring the upgrading of the operating system as disclosed in Mohammed and from determining whether an application exists on a client computer as disclosed in Yinger. Applicants therefore respectfully submit that claim 15 is not obvious in view of Yinger and Mohammed either individually or in combination.

CONCLUSION

Given the various differences between the claimed inventions and the prior art, Applicants respectfully ask that the Examiner allow all the present claims and issue a notice of allowance in due course. If any fees or time extensions are inadvertently omitted or if any fees have been overpaid, please appropriately charge or credit those fees to Conley Rose Deposit Account Number 03-2769 and enter any time extension(s) necessary to prevent this case from being abandoned.

Respectfully submitted,

Jonathan M. Harris
PTO Reg. No. 44,144
CONLEY ROSE, P.C.
(713) 238-8000 (Phone)
(713) 238-8008 (Fax)
ATTORNEY FOR APPLICANTS

142744.02/2085.00100

-Page 16 of 20-

Amendments to the Drawings:

The attached sheets of drawings includes the addition of Figure 2a.

Attachment: Replacement Sheets